

Remarks

1. Summary of the Office Action

In the office action mailed March 8, 2006, the Examiner provisionally rejected claims 1, 6-12, 20-26, and 28-36 on grounds of obviousness type double patenting over co-pending U.S. Patent Application No. 09/893,137. In addition, the Examiner rejected claims 1, 13-19, and 37 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,944,150 (McConnell). Further, the Examiner rejected claims 2-12 under 35 U.S.C. § 103(a) as being allegedly obvious over a combination of McConnell and U.S. Patent No. 6,614,781 (Elliott), and the Examiner rejected claims 20-36 under 35 U.S.C. § 103(a) as being allegedly obvious over a combination of McConnell and U.S. Patent No. 6,529,513 (Howard).

2. Status of the Claims

Pending in this application are claims 1-37, of which claims 1, 2, 13, 20, and 37 are independent and the remainder are dependent.

3. Response to Rejections

a. Response to Double Patenting Rejections

As noted above, the Examiner provisionally rejected claims 1, 6-12, 20-26, and 28-36 on grounds of obviousness-type double-patenting over co-pending U.S. Patent Application No. 09/893,137. Applicants submit herewith a terminal disclaimer with respect to the cited co-pending application, thereby overcoming this provisional double patenting rejection. In doing so, Applicants do not address or acquiesce in the Examiner's assertions that the claims of the applications are not patentably distinct from each other. Rather, Applicants submit the terminal disclaimer in order to expedite prosecution and allowance.

b. Response to § 102(e) Rejections

The Examiner next rejected claims 1, 13-19, and 37 as being anticipated by McConnell. Of these claims, claims 1, 13, and 37 are independent.

i. Claim 1

In rejecting claim 1, the Examiner asserted that McConnell teaches at column 8, lines 26-32, the claim 1 element of "receiving a request to establish a circuit-data session between a user terminal and a specified destination," and the Examiner asserted that McConnell teaches at column 7, lines 58-67, the claim 1 element of "responsively setting up a packet-data session between the user terminal and a translation node". Applicants respectfully submit that this reading of McConnell is in error.

First, the portions of McConnell cited by the Examiner necessarily fail to teach the "responsively" function of claim 1. This is evident initially from the fact that the cited portion at column 7 comes *before* the cited portion at column 8 in McConnell, although the Examiner has asserted that the portion at column 7 describes something occurring *in response to* what is described at column 8. Moreover, a review of these portions reveals no such responsiveness. The portion at column 8 describes extending a packetized signal to the PSTN for delivery to a PSTN terminal, and the portion at column 7 describes a wireless access gateway (WAG) receiving signals from a mobile station as baseband signals or as IP packets. Other than using some keywords similar to words in claim 1 (such as "circuit-switched", "packet-switched", and "terminal") and generally discussing the concept of a circuit/packet translation node (namely, "trunk gateway" 64 or WAG 60), these cited portions do not relate to the combination of claim 1 elements that the Examiner said the portions describe.

Furthermore, the first element of claim 1 recites "receiving a request to establish a circuit-data session between a user terminal and a specified destination." The term "specified destination" in this element makes clear that the specified destination is a *destination* for the session, rather than a point of origin of the session. Thus, the cited disclosure at column 8 of McConnell, which relates to connecting a session *to* a user terminal (and thus from another point), does not amount to receiving a request to establish a circuit-data session between a user terminal and a *specified destination* as in claim 1.

Still further, the Examiner asserted that McConnell teaches at column 10, lines 9-25, the claim 1 element of the translation node (with which a packet-data session is set up with the user terminal in response to a request to establish a circuit-data session between the user terminal and a specified destination) being programmed to set up a circuit-data session with the specified destination and to bridge the packet-data session with the circuit-data session. Applicants respectfully submit that this reading of McConnell is in error as well.

The cited portion at column 10 of McConnell does not teach the translation node functionality recited in claim 1. Indeed, the cited portion at column 10 of McConnell refers merely to a WAG and session manager working to set up a packet-data session. In particular, it describes the WAG receiving a request from a mobile station to set up a packet-data session, the WAG signaling to a session manager, the session manager engaging in signaling to set up the packet-data session with a remote gateway, and the communication commencing over a packet network. At a minimum, this portion of McConnell does not mention anything about bridging a packet-data session with a circuit-data session as in claim 1.

In summary, the Examiner has not established that McConnell teaches the invention as recited in claim 1. Rather, at best, the Examiner has cited to some portions of McConnell that have similar keywords and discuss relates concepts such as setting up calls over circuit-switched connections and packet-switched connections, but those cited portions do not amount to the invention as particularly recited in claim 1. Consequently, Applicants submit that claim 1 is allowable.

ii. Claims 13-19

In rejecting claim 13, the Examiner similarly relied on the above-discussed portions of McConnell at column 8 and column 10. For largely the same reasons discussed above with respect to claim 1, Applicants submit that the Examiner has not established that McConnell teaches the invention recited in claim 13. Thus, Applicants submit that claim 13 is allowable. Furthermore, without conceding the Examiner's assertions regarding claims 14-19, Applicants submit that claims 14-19 are allowable for at least the reason that they depend from an allowable claim.

iii. Claim 37

In rejecting claim 37, the Examiner asserted that McConnell teaches at column 13, lines 16-26, the claim 37 elements of (i) "a mobile user terminal programmed to respond to a request to establish a dial-up data session with a designated endpoint by instead initiating a first packet-data session with a packet gateway, wherein the packet gateway passes packet-data between the mobile user terminal and a local server" and (ii) "the remote server being programmed to initiate a circuit-data session with the designated endpoint, to translate the packet-data into circuit-data, and to send the circuit-data to the designated endpoint in the circuit-data session". Applicants respectfully submit that this reading of McConnell is in error.

The cited portion of McConnell at column 13 teaches that a mobile station or other terminal can use SIP signaling or other signaling to establish a communication session, such as by engaging in SIP communication with a SIP server, and further that the WAG and session manager can function as SIP servers. This disclosure does not amount to the claim 37 elements that the Examiner asserted it does.

Because the Examiner has not pointed out any disclosure that teaches the invention particularly recited in claim 37, Applicants submit that claim 37 is allowable.

c. Response to § 103(a) Rejections

The Examiner next rejected claims 2-12 and 20-36 under 35 U.S.C. § 103 as being allegedly obvious over a combination of McConnell and either of two secondary references. Applicants submit that these § 103 rejections should be withdrawn, because McConnell is disqualified as prior art under 35 U.S.C. § 103(c).

At the time the present invention was made, both the present invention and the McConnell patent application were commonly owned or subject to an obligation of assignment to the same person. In particular, at the time the present invention was made, (i) the present invention was assigned or subject to an obligation of assignment to Sprint Spectrum L.P., (ii) the McConnell patent application was assigned or subject to an obligation of assignment to Sprint Communications Company L.P., and (iii) Sprint Spectrum L.P. and Sprint Communications Company L.P. were each 100% owned by Sprint Corporation. According to "Example 1" set forth in M.P.E.P. § 702.02(l)(2)(I), this scenario disqualifies the cited reference as prior art under 35 U.S.C. § 103(c).

Since McConnell is disqualified as prior art, a *prima facie* case of obviousness of claims 2-12 and 20-36 does not exist. Consequently, Applicants submit that claims 2-12 and 20-36 are allowable.

4. Conclusion

For the foregoing reasons, Applicants submit that all of the pending claims are allowable, and thus Applicants respectfully request favorable reconsideration.

Should the Examiner wish to discuss any aspect of this application, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

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